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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/727,953	11/30/2000	Guy McIlroy	PALM-3281.US.P	5875
49637 7590 08/13/2007 BERRY & ASSOCIATES P.C. 9255 SUNSET BOULEVARD SUITE 810 LOS ANGELES, CA 90069			EXAMINER KHOSHNOODI, NADIA	
			ART UNIT 2137	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/727,953

Applicant(s)

MCILROY, GUY

Examiner

Nadia Khoshnoodi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 May 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

Applicant's arguments/amendments with respect to amended claims 1, 8, & 18 and original/previously presented claims 2-7, 9-17, and 19-21 filed 5/17/2007 have been fully considered but they are not persuasive. The Examiner would like to point out that this action is made final (See MPEP 706.07a).

Response to Arguments

Applicants contend that Mohammed et al. fail to teach/suggest "the limitations of a host facility and a portable computing device." Examiner would like to point out that Mohammed et al., taken alone, was not relied upon as teaching this limitation (as shown in the previous rejection for claim 3 as well as the other independent claims). Mohammed et al. taken in combination with Brody et al., however, do teach/suggest an environment which incorporates a host facility and a portable computing device. Before referencing the Brody publication, the Examiner would like to point out that in Applicant's Specification, a "host computer" is any computer capable of synchronization with any palmtop device (See page 11, lines 18-21). Keeping in mind the scope of the terms used in the claim, Brody et al. specifically suggest personalizing a portable computing device/handheld device via a connection through a host/network (par. 33, lines 1-30). Various types of personalizations may occur by loading software to the PDA, as disclosed by Brody et al. (par. 94-96). Finally, Brody et al. suggest that it could be beneficial to incorporate a feature which validates the software to ensure that no viruses have been implanted, based on whether or not that is a goal of the invention (par. 105).

All of these citings suggest that the motivation to combine Brody et al. and Mohammed et al. would be to prevent the spread of viruses/worms during the personalization process (par. 163). Therefore, it would have been obvious to one of ordinary skill, at the time the invention was made, to incorporate a validation check so that if the software has malicious code there will be a means in place to at least try and prevent that device from becoming infected. Thus, the combination of Mohammed et al. and Brody et al. teach/suggest the claimed limitations.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Brody et al. suggest that it could be beneficial to incorporate a feature which validates the software to ensure that no viruses have been implanted, based on whether or not that is a goal of the invention (par. 105 and par. 163).

Claim Objections

Claim 3 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Specifically, Applicants have amended claim 1 to incorporate the limitations of claim 3 without canceling claim 3. Appropriate correction is required.

Claim Rejections - 35 USC § 103

I. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

II. Claims 1-5, 7-13, 15-18, and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mohammed et al., US Patent No. 6,374,357 and further in view of Brody, US Pub. No. 2001/0051928.

As per claim 1:

Mohammed et al. teach a method of ensuring the security of a computer system, comprising loading software on said computer system suitable for operating on the computer system (col. 6, lines 12-32 and col. 18, lines 13-15); prior to operating the software on the computer system, validating said software by the use of a validator program that scans the software that is loaded in a secure environment (col. 18, line 56 – col. 19, line 5); marking said software as valid or invalid by the use of a digital signature flag (col. 18, line 63 – col. 19, line 15); and, denying said software the ability to operate on any environment within said computer system if said validator fails to identify said software as valid in order to ensure the security of said computer system (col. 19, lines 4-12). Furthermore, Mohammed et al. teach that the computing environment allows for various computing systems, one of which may be a handheld device (col. 6, lines 21-26).

Not explicitly disclosed is wherein said method operates on a computer system which comprises a portable computing device coupled to said host computer. However, Brody teaches

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a PDA coupled to a host device for personalization purposes. Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the method disclosed in Mohammed et al. to have the hand-held device coupled to the host computer in order to carry out different functions on the portable device. This modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, would have been motivated to do so since Brody suggests that PDA's are used in conjunction with PC's in order to download applications because PDA's are highly mobile and the client can always have access to his/her PDA in par. 33, lines 1-30 and par. 163.

As per claim 2:

Mohammed et al. teach the method described in claim 1 wherein said method operates on an open platform computer system (col. 5, line 66 – col. 6, line 32).

As per claim 3:

Mohammed et al. substantially teach the method described in claim 1. Mohammed et al. also teach a host computer (col. 6, lines 33-38). Furthermore, Mohammed et al. teach that the computing environment allows for various computing systems, one of which may be a handheld device (col. 6, lines 21-26). Furthermore, Brody et al. teach wherein said method operates on a computer system which comprises a portable computing device coupled to said host computer (par. 33, lines 1-30).

As per claim 4:

Mohammed et al. teach the method described in claim 1 wherein said software is supplied by a third-party source (col. 9, lines 51-63).

As per claim 5:

Mohammed et al. teach the method described in claim 4 wherein said third-party software is for execution or other use on a palmtop computer (col. 6, lines 33-38).

As per claim 7:

Mohammed et al. substantially teach the method described in claim 1. Mohammed et al. also teach a host computer (col. 6, lines 33-38). Furthermore, Mohammed et al. teach that the computing environment allows for various computing systems, one of which may be a handheld device (col. 6, lines 21-26). Not explicitly disclosed is wherein said method operates on a computer system which comprises a palmtop computing device coupled to said host computer. However, Brody teaches a PDA coupled to a host device for personalization purposes.

Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the method disclosed in Mohammed et al. to have the hand-held device coupled to the host computer in order to carry out different functions on the palmtop computing device. This modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, would have been motivated to do so since Brody suggests that PDA's are used in conjunction with PC's in order to download applications because PDA's are highly mobile and the client can always have access to his/her PDA in par. 33, lines 1-30.

As per claim 8:

Mohammed et al. substantially teach an apparatus for ensuring the security of software in a computer system, comprising a validation program that is capable of validating said software by first scanning said software that is loaded in a secure environment (col. 18, line 56 – col. 19, line 5); marking said software as valid or invalid by the use of a digital signature flag (col. 18, line 63 – col. 19, line 15); and, denying said software the ability to operate in any environment

on said computer system if said validator program fails to identify said software as valid in order to ensure the security of said computer system (col. 19, lines 4-12). Furthermore, Mohammed et al. teach that the computing environment allows for various computing systems, one of which may be a handheld device (col. 6, lines 21-26).

Not explicitly disclosed is wherein a portable computing device is coupled to a host computer, wherein said portable computing device is capable of loading software from said host computer to said portable computing device for operating on said portable computing device. However, Brody teaches a PDA coupled to a host device and can load software for personalization purposes. Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the method disclosed in Mohammed et al. to have the hand-held device coupled to the host computer in order to carry out different functions on the palmtop computing device. This modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, would have been motivated to do so since Brody suggests that PDA's are used in conjunction with PC's in order to download applications because PDA's are highly mobile and the client can always have access to his/her PDA in par. 33, lines 1-30.

As per claim 9:

Mohammed et al. and Brody substantially teach the apparatus described in claim 8. Furthermore, Brody teaches wherein said host computer is coupled to a network (par. 33, lines 1-30).

As per claim 10:

Mohammed et al. and Brody substantially teach the apparatus described in claim 8. Furthermore, Brody teaches wherein said portable computing device is a handheld computing device (par. 33, lines 1-30).

As per claim 11:

Mohammed et al. and Brody substantially teach the apparatus described in claim 8. Furthermore, Brody teaches wherein said portable computing device is a personal data assistant (par. 33, lines 1-30).

As per claim 12:

Mohammed et al. and Brody substantially teach the apparatus described in claim 8. Furthermore, Brody teaches wherein said portable computing device is coupled to said host computer by an infrared device (par. 33, lines 25-30).

As per claim 13:

Mohammed et al. and Brody substantially teach the apparatus described in claim 8. Furthermore, Brody teaches wherein said portable computing device is coupled to said host computer by an RF enabled device (par. 33, lines 25-30).

As per claim 15:

Mohammed et al. and Brody substantially teach the apparatus described in claim 8. Mohammed et al. further teach wherein said validation program is configured to evaluate third-party software and attach a digital "valid" flag if said third-party software is found to be clean of known security compromising routines or attach a digital "invalid" flag to said third-party software if said third-party software is not found to be clean of known security compromising

routines (col. 18, line 35 – col. 19, line 15).

As per claim 16:

Mohammed et al. and Brody substantially teach the apparatus described in claim 15.

Mohammed et al. further teach wherein said portable computing device is configured to load third-party software files with said digital "valid" flag attached and to refrain from loading third-party software files which have no flag attached or have said "invalid" flag attached (col. 19, lines 4-15).

As per claim 17:

Mohammed et al. and Brody substantially teach the apparatus described claim 15.

Furthermore, Brody teaches wherein said portable computing device is a personal data assistant (par. 33, lines 1-30).

As per claim 18:

Mohammed et al. substantially teach an apparatus for ensuring the security of a computer system, comprising a validation program that is capable of validating said software by scanning the files of said software in a secure environment on the handheld computing device prior to operating the software in any environment on the handheld computing device (col. 18, line 56 – col. 19, line 5); marking said software as valid or invalid by the use of a digital signature flag (col. 18, line 63 – col. 19, line 15); and denying said software the ability to operate on any environment on said computer system if said validator fails to identify said software as valid in order to ensure the security of said computer system (col. 19, lines 4-12). Furthermore, Mohammed et al. teach that the computing environment allows for various computing systems, one of which may be a handheld device (col. 6, lines 21-26).

Not explicitly disclosed is a handheld computing device couple to a network, wherein said handheld computing device is capable of loading software from said network to said handheld computing device for operating on said handheld computing device. However, Brody teaches a PDA coupled to a network and can load software from a network for personalization purposes. Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the method disclosed in Mohammed et al. to have the hand-held device coupled to the network computer in order to carry out different functions on the palmtop computing device. This modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, would have been motivated to do so since Brody suggests that PDA's are used in conjunction with PC's in order to download applications because PDA's are highly mobile and the client can always have access to his/her PDA in par. 33, lines 1-30.

As per claim 20:

Mohammed et al. and Brody substantially teach the apparatus described in claim 18. Mohammed et al. further teach wherein said portable computing device is configured to load third-party software files with said digital "valid" flag attached and to refrain from loading third-party software files which have no flag attached or have said "invalid" flag attached (col. 19, lines 4-15).

As per claim 21:

Mohammed et al. and Brody substantially teach the apparatus described in claim 18. Mohammed et al. further teach wherein said validation program is configured to evaluate third-party software and attach a digital "valid" flag if said third-party software is found to be clean of

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known security compromising routines or attach a digital "invalid" flag to said third-party software if said third-party software is not found to be clean of known security compromising routines (col. 18, line 35 – col. 19, line15).

III. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mohammed et al., US Patent No. 6,374,357 as applied to claim 1 above, and further in view of Ginter et al., US Patent No. 6,948,070.

As per claim 6:

Mohammed et al. substantially teaches the method described in claim 1. Not explicitly disclosed is wherein said validator program is specially constructed to reside in a secure fashion in said computer system. However, Ginter et al. teach the use of a tamper-resistant security barrier so that processes are ensured to be carried out within a secure environment. Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the method disclosed in Mohammed et al. for the validator program to be contained within a secure environment in order to ensure that it has not been tampered with so that it correctly validates the software/application. This modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, would have been motivated to do so since Ginter et al. suggests that it is important to ensure that processes are carried out within a secure environment in col. 59, lines 48-59.

IV. Claims 14 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mohammed et al., US Patent No. 6,374,357 and Brody, US Pub. No. 2001/0051928 as applied to claims 8 and 18 above, and further in view of Ginter et al., US Patent No. 6,948,070.

As per claim 14:

Mohammed et al. and Brody substantially teach the apparatus described in claim 8. Not explicitly disclosed is wherein said validation program resides in said host computer in a fashion intended to be secure. However, Ginter et al. teach the use of a tamper-resistant security barrier so that processes are ensured to be carried out within a secure environment. Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the apparatus disclosed in Mohammed et al. for the validator program to be contained within a secure environment in order to ensure that it has not been tampered with so that it correctly validates the software/application. This modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, would have been motivated to do so since Ginter et al. suggests that it is important to ensure that processes are carried out within a secure environment in col. 59, lines 48-59.

As per claim 19:

Mohammed et al. and Brody substantially teach the apparatus described in claim 18. Not explicitly disclosed is wherein said validation program resides in said computer network in a fashion intended to be secure. However, Ginter et al. teach the use of a tamper-resistant security barrier so that processes are ensured to be carried out within a secure environment. Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the apparatus disclosed in Mohammed et al. for the validator program to be contained within a secure environment in order to ensure that it has not been tampered with so that it correctly validates the software/application. This modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, would have been motivated

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to do so since Ginter et al. suggests that it is important to ensure that processes are carried out within a secure environment in col. 59, lines 48-59.

**References Cited, Not Used*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1. US Patent No. 6,694,436
2. US Patent No. 5,953,502

The above references have been cited because they are relevant due to the manner in which the invention has been claimed.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nadia Khoshnoodi whose telephone number is (571) 272-3825.

The examiner can normally be reached on M-F: 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Nadia Khoshnoodi
Examiner
Art Unit 2137
8/7/2007

NK



EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER